



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/808,358
Applicant : JEFF A. LAMBERT, ET AL.
Filed : MARCH 25, 2004
Title : RECONFIGURABLE ELECTRONIC DEVICE CHASSIS AND
INTERCHANGEABLE ACCESS PANELS FOR USE IN SAME

Confirmation: 4732
Art Unit : 2835
Examiner : PAPE, ZACHARY

Atty Docket No. : 200312909-1

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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1. In conjunction with the Notice of Appeal concurrently filed for the above application involving claims 1-7 and 9-15 on appeal, Applicants respectfully request a pre-appeal review further to the Official Gazette Notice of July 12, 2005, which authorizes Pre-Appeal Brief Conferences.

I. Basis for Request for Review

2. This request is necessitated by the failure of the Final Office Action dated May 3, 2006 to articulate a *prima facie* case of obviousness under MPEP §§ 706.02(j) and 2143. Specifically, the Final Office Action fails to provide a motivation to combine of the various references relied on to rejection of claims 1-7 and 9-15 under 35 U.S.C. § 103(a).

3. The Final Office Action failed to articulate a suggestion or motivation to combine the references and thus failed to establish a *prima facie* case of obviousness under MPEP §§ 706.02(j) and 2143. The Examiner asserts that Yu '930 teaches all limitations of previously presented claims 1 and 6, except for the feature of "at least one exterior wall is entirely vacated." (See, Final Office Action, page 3.). The Examiner cites Yu '386 for teaching "a computer chassis for an electronic device comprising a vacated exterior wall (20) which can be placed in the vacated portion to complete the full assembly of the chassis." (See, Final Office Action, page 3.). The Examiner clarified the use of teachings

of Yu '386 by stating that "the examiner was using Yu '386 only to teach vacating an entire wall of a chassis as claimed." (See, Final Office Action, page 7; also the "examiner is merely using the Yu '386 references to teach 'at least one exterior wall ... entirely vacated'"). To support the motivation to combine these two references, the Final Office Action states that it "would be obvious to one of ordinary skill in the art at the time of the invention was made to modify the interchangeable access panel of Yu '930 to include the entire rear panel as taught by Yu '386 to provide better access to the components of the computer system (See Column 1, Lines 40-42; having a removable panel as taught by Yu '386 provides for better access to the components compared to the partial opening of Yu '930)." (See, Final Office Action, page 4.). The Examiner emphasizes that "the Yu '386 reference teaches the motivation listed by the examiner." (See, Final Office Action, page 6.). In addition, in the previous Office Action of November 23, 2005, the Examiner claims to address the previously lack of motivation by stating that "the examiner has explicitly cited motivation in the second Yu reference." (See, Office Action, page 4.).

4. The Examiner has not provided proper support for the assertion that one of ordinary skill, without having the benefit of Applicants' novel teachings before them, would have been motivated to combine the teachings of the two references. In doing so, the Examiner failed to articulate a suggestion or motivation to combine the references and thus failed to establish a *prima facie* case of obviousness as required by law and under MPEP Sections 706.02(j) & 2143. (See, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.")). Sufficient evidential support for the motivation to combine must be shown in the prior art suggesting a combination of references. (See, *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002); see also, *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.")).

5. The only statement regarding the motivation to combine Yu '930 with Yu '386 to reject claims 1 and 6, is "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the interchangeable access panel of Yu '930 to include the entire rear panel as taught by Yu '386 to provide *better access* to the

components of the computer system.” (*See*, Office Action, page 4; emphasis added.). The alleged evidence to support the motivation of Yu ‘930 and Yu ‘386 comes only from Yu ‘386. The motivation to combine fails because the general advantage of “better access” is not supported by any evidence that one possessing Yu ‘930 would be motivated to modify Yu ‘930 in light of Yu ‘386. Applicants are not arguing that the motivation to combine must come only from a primary reference, but that the motivation identified and repeated by the Examiner from the secondary reference, namely Yu ‘386, is not sufficient to supply evidence that one would be motivated to modify Yu ‘930 in light of Yu ‘386. The Examiner rests on generalized statements of advantages without regard to the desirability or the feasibility of modifying Yu ‘930. The Examiner has not and cannot identify any portion of Yu ‘930 which points to obtaining the general advantage as suggested by the Examiner. Instead, the Examiner has identified an advantage of Yu ‘386, namely “better access”, and improperly imported that advantage to Yu ‘930 without any support for that motivation. This bald assertion of “better access” is not a substitute for the absence of objective reasons, sufficient evidence and reasoned findings.

6. Further, the Examiner is assuming that the type of access taught by Yu ‘386 would provide “better access” when combined with Yu ‘930. “Better access” is a relative term that requires an improvement in access of one device over another. Based on the Examiner’s statements, having an interchangeable panel from Yu ‘930 occupying the entire rear wall as taught by Yu ‘386 provides better access than an interchangeable panel of Yu ‘930 which fills a window on a rear wall. Applicants respectively disagrees with the Examiner’s assumptions based on the teachings of the cited prior art references. Yu ‘386 is directed toward a detachable front and top portion that provides access to computer equipment. (*See*, Yu ‘386, Col. 1, lines 42-43.). Contrary to the Examiner’s assertions, the fact that Yu ‘386 provides “a computer case, which facilitates the replacement, update and maintenance of computer equipment” does not mean that Yu ‘386 provides “better access.” Compared with Yu ‘386, Yu ‘930 discloses an interchangeable panel for a window in the rear that provides access based on the type of motherboard present. (*See*, Yu ‘930, Col. 5, lines 35-41.) There is nothing to indicate that access provided by the interchangeable panels of Yu ‘930 would be better if these panels “included[d] the entire rear panel as taught by Yu ‘386.” (*See*, Final Office Action, page 3.) Instead, Yu ‘930 teaches away from the “better access” as alleged by the Examiner. Yu ‘930 states that “the computer

case can be readily used in upgrades by permitting swapping of the mother board without replacement of the case.” (See, Yu ‘930, Col. 5, lines 39-41.) Having an entire rear wall replaced as allegedly taught by Yu ‘386, and thus replacing the case, would be contrary to Yu ‘930 which seeks not to replace the case. The Examiner’s assumption that the interchangeable panels of Yu ‘930 would provide better access using the entire rear wall as allegedly taught by Yu ‘386 is contrary to Yu ‘930 which does not seek to replace the case. Thus, it is clear that one would not be motivated to modify Yu ‘930 in light of Yu ‘386 because Yu ‘930 does not seek to obtain the assumed “better access.”


7. In relying on this general advantage, the Examiner has not objectively explained the motivation to combine Yu ‘930 with Yu ‘386. Based on Federal Circuit precedent it can be reasonably assumed the Examiner selected the references with the assistance of hindsight. (See, *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998).) The Federal Circuit has repeatedly stated that the use of hindsight must be guarded against by having the Examiner provide sufficient evidence to support the motivation. (See, e.g., *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).) In the present application, the use of hindsight by the Examiner is exhibited by the use of a general advantage, without any evidence as discussed above, and the use of two separate prior art references which allegedly show all the elements. Instead of using the prior art references or other evidence to combine Yu ‘930 in light of Yu ‘386, the Examiner using Applicants’ specification as roadmap to allegedly find all the elements in both references. The motivation to combine is a result of Applicants’ specification instead of sufficient objective evidence provided by the Examiner. Therefore, without sufficient objective evidence the Examiner fails to establish a proper *prima facie* case of obviousness to combine Yu ‘930 with Yu ‘386, and thus the rejection of claims 1 and 6 should be withdrawn.

II. Relief Requested

8. For reasons given above, the Final Office Action that was issued in the present application is grossly deficient and in violation of the Rules of Practice, outlined the MPEP. The failure of the Final Office Action to establish a *prima facie* obviousness rejection is improper.

9. Therefore, Applicants request that all of the rejections be withdrawn and claims 1-7 and 9-15 be allowed. In the alternative, Applicants request that the finality of the Final Office Action be withdrawn.

Respectfully submitted,



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June 12, 2006